

REMARKS

Claims 6-14, 16 and 17 are pending in the present application. Claims 1-5 and 15 have been canceled.

Claim Amendments

By this amendment, composition claims 1-5 and 15 are cancelled. No new matter is added by this amendment.

Rejection under 35 USC 103(a)

Claims 1-17 stand rejected under 35 USC 103(a) as being unpatentable over Hirose et al '234 in view of Nishi et al '670. This rejection is respectfully traversed.

In support of the rejection, the Examiner takes the position at page 3 of the Action that the resin of Nishi et al, while preferably employed in the automobile industry as a topcoat, is not limited in use therein. The Examiner further takes the position that the resin of Nishi et al "comprises an acrylic resin in combination with an amide containing polymer" which forms a curable/polymerizable coating", with Nishi et al being cited to teach a suitable amount of an amide monomer combined with an acrylic resin.

In response, composition claims 1-5 and 15 are cancelled. Only claims 6-14, 16 and 17 remain under rejection. Claims 6-13, 16 and 17 are directed to a lithographic printing original plate, while claim 14 is directed to a photosensitive resin composition (as defined) for use in a lithographic printing plate containing a limited number of amide compounds.

By way of review, applicants' invention is directed to a photosensitive resin composition for lithographic printing plate and a printing original plate utilizing a fountain solution. The inventive photosensitive resin composition for a lithographic printing plate comprises not less than 10 % by weight and not more than 90 % by weight of a hydrophilic polymer having at least a hydrophilic group, based on the amount of the photosensitive resin composition, and not less

than 0.5 % by weight and not more than 20 % by weight, based on the amount of the hydrophilic polymer, of a compound that inhibits hydrogen bonding (hereinafter the “**Inhibiting Compound**”) within the molecule and/or between the molecules of the hydrophilic polymer. The advantages of a lithographic printing plate or a lithographic printing original plate containing the inventive photosensitive resin composition is that it is sensitive to light in the near infrared region, and can be handled even in a bright room. Also, drawing can directly be made with a laser beam, and there is no need for development and wiping-off procedures. These advantages are not seen in, nor suggested by, the references cited by the Examiner.

According to MPEP 2141, when applying prior art pursuant to 35 USC 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

Applicants respectfully submit that upon reading the cited references, it is clear that these four tenets have not been followed. The Examiner appears to be taking the position that picking and choosing elements of two disparate references from unrelated art areas is in the purview of the skilled artisan. However, the hypothetical skilled artisan (used in the analysis under 35 USC 103) would be restrained by what is fairly suggested in the prior art, not just what is remotely possible.

Even if the hypothetical skilled artisan would consider, at the outset, combining any aspect of a product of one reference with an aspect of the product taught in another reference, the skilled artisan would only consider obvious combining aspects from various references which would provide a reasonable expectation of success. In so doing, the skilled artisan must consider the implications of not including aspects of any of the disclosed inventions of the prior art which

are required parts of the inventions of the prior art. It is clear that the negative implications are greater when the excluded part is a required feature of the prior art reference and is not just disclosed as a preferred embodiment.

In view of the above, it is clear that the combined teachings of the references relied upon by the Examiner fail to teach or suggest the claimed invention.

In the first paragraph of page 2 of the outstanding Office Action, the Examiner has taken the position that Hirose et al. cannot stand alone in making the present invention obvious, since Hirose et al. fail to teach or fairly suggest that the concentration of the Inhibiting Compound can be not less than 0.5 % by weight and not more than 20 % by weight, based on the amount of the hydrophilic polymer, as presently claimed. Accordingly, the Examiner relies on Nishi et al. Applicants assume that the Examiner is equating the inventive "Inhibiting Compound" with the "amide group-containing ethylenic monomer" of Component (A) of Nishi et al.

However, Applicants respectfully submit that the combination of references is improper and that the combination of references do not make the present invention obvious. The mere fact it is possible for isolated disclosures to be combined does not render the result of that combination obvious absent a logical reason of record, which justifies the combination. *In re Regel et al.* (CCPA 1975) 526 F2d 1399, 188 USPQ 136.

Applicants continue to note that the references are each directed to different fields of endeavor. Hirose et al. teach compositions useful in lithographic printing plates, whereas Nishi et al. teach compositions useful for intercoating and base topcoating of automobiles. MPEP 2143.01 cites two cases having similar fact situations where it was found that the combination was improper, i.e., *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992).

In the case of *In re Fine, supra*, the claims were directed to a system for detecting and measuring minute quantities on nitrogen compounds comprising a gas chromatograph, a converter which converts nitrogen compounds into nitric oxide by combustion, and a nitric oxide

detector. The primary reference disclosed a system for monitoring sulfur compounds comprising a chromatograph, combustion means, and a detector, and the secondary reference taught nitric oxide detectors. The examiner and Board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference. However, the court found there was no support or explanation of this conclusion and reversed.

Also, in the case of *In re Jones*, the claimed invention was the 2-(2'-aminoethoxy) ethanol salt of dicamba, a compound with herbicidal activity. The primary reference disclosed *inter alia* the substituted ammonium salts of dicamba as herbicides. However, the reference did not specifically teach the claimed salt. Secondary references teaching the amine portion of the salt were directed to shampoo additives and a byproduct of the production of morpholine. The court found there was no suggestion to combine these references to arrive at the claimed invention.

Should the Examiner maintain this rejection, the Examiner is invited to explain why the skilled artisan would look to the teachings of Nishi et al. relating to compositions useful for intercoating and base topcoating of automobiles to modify the composition of Hirose et al. useful in lithographic printing plates.

Applicants note that the Examiner at page 3 of the Action attempts to bridge the gap between the respective technology areas of the cited references by overlooking the differences therebetween while overstating the similarities by stating that the resin of Nishi is a “curable/polymerizable coating that comprises an acrylic resin in combination with an amide – coating monomer, a solvent, and a polymerization initiator.” While this characterization may be accurate, it does nothing to support the asserted substitution of the teachings of Nishi et al for those of Hirose et al.

Further, Nishi et al. *requires* component (B) in the composition, which is a polycarbonate. Hirose et al. do not teach or suggest the use of a polycarbonate. As mentioned above, the skilled artisan would only consider obvious combining aspects from various references which would provide a reasonable expectation of success. In the instant case, the

skilled artisan must consider the implications of including or not including the polycarbonate in the composition of Hirose et al., since the polycarbonate is a required component of the composition of Nishi et al. It is clear that the negative implications on the skilled artisan's expectation of success would be high given the disparate uses of the compositions of Hirose et al. and Nishi et al.

Importantly, applicants note that the Examiner relies upon Nishi et al. to teach that the concentration of the "amide group-containing ethylenic monomer" should be within the inventive range of 0.5-20 wt% (as presently claimed) for the reason that Nishi et al. teach that this concentration range improves "the curing and dispersion properties of the film." (See the Examiner's comments on page 3 of the Office Action). However, Nishi et al. teach:

When the amount is smaller than 5% by weight, *the flake metal pigment is not sufficiently oriented*, which results in deterioration of appearance. On the other hand, when the amount exceeds 40% by weight, *water resistance of the resulting coat is deteriorated*. (See column 4, lines 1-5 of Nishi et al.).

The advantages provided by the concentration range of the "amide group-containing ethylenic monomer" of Nishi et al. clearly have nothing to do with, and are unrelated to, those advantages pertaining to the curing and dispersion properties of the present invention. Furthermore, Hirose et al. intend to improve the resistance to scumming on the unirradiated areas and the ink receptivity of the irradiated areas of the printing original plate. See the "Evaluation" section beginning at paragraph 0097 of Hirose et al.

Accordingly, in view of the above-described distinctions between the teachings of Nishi et al. and Hirose et al., the skilled artisan would not be motivated to look to Nishi et al. to modify the composition of Hirose et al. As such, the combination of Nishi et al. and Hirose et al., do not make the inventive resin composition obvious.

Applicants further direct the Examiner's attention to various of the limitations of the claims which are neither taught nor suggested by the cited prior art. For instance, the


embodiment wherein Y1 and Y2 taken together may form a ring is neither disclosed nor taught by the cited prior art.

In view of the fact that Hirose et al. fail to teach or fairly suggest a photosensitive resin composition using 0.5-20 % by weight (as presently claimed) of the Inhibiting Compound, and the skilled artisan would not be motivated to look to the teachings of Nishi et al. to modify Hirose et al. in the manner asserted by the Examiner, a *prima facie* case of obviousness cannot be said to exist. Accordingly, withdrawal of the rejection is respectfully requested.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq. (Reg. No. 43,575) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.


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Respectfully submitted,

By maury (02-070,069)

Raymond C. Stewart

Registration No.: 21,066

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant